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501.18758C14

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: K. SHIMOHIGASHI et al.
Serial No.: 08/448,138
Filed: May 23, 1995
For: SEMICONDUCTOR MEMORY
Group: 2511
Examiner: T. Fears

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Reconsideration
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REQUEST FOR RECONSIDERATION

Assistant Commissioner for Patents
Washington, D.C. 20231

March 7, 1997

Sir:

The present Request for Reconsideration is in response to the Office Action dated June 5, 1996 and the Office Action dated October 15, 1996 (correcting and resetting the time for response).

By the above-noted Office Actions, two issues remain in the application. The first of these is the question of whether a new declaration is required to include the "reviewed and understands" clause. The second question concerns a non-obviousness/non-statutory type double patenting rejection of claims 20-25 based on claims 1-6 of the parent patent 5,448,520.

In response to the requirement for a new declaration, applicants respectfully request reconsideration of this point. With regard to this, it is noted that the declaration in question was filed with the original parent application. As

such, the declaration was signed by the four different inventors between April 28, 1982 and May 8, 1982. Therefore, the rules in effect at that time can be found in the Code of Federal Regulations, Volume 37, revised as of July 1, 1981 (noting that these rules were in effect between July 1, 1981 and July 1, 1982). More specifically, 37 CFR 1.65 from the Code of Federal Regulations as revised July 1, 1981 dictates the requirements for the declaration which was executed by the inventors in April and May of 1982.

For the Examiner's convenience, a copy of 37 CFR 1.65 from the Code of Federal Regulations revised on July 1, 1981 is attached herewith as Exhibit 1. A review of 37 CFR 1.65 which was in effect at that time indicates that there is no requirement for any statement that the inventors had reviewed and understood the specification as of the time the inventors executed the declaration in question in April and May of 1982. Therefore, it is respectfully submitted that the declaration was fully in compliance with 37 CFR 1.65 set forth in the Code of Federal Regulations, Volume 37, which was effective between July 1, 1981 and July 1, 1982. Therefore, reconsideration and removal of the requirement for a new declaration is respectfully requested.

With regard to the question of the declaration, it is noted that this application was filed under 37 CFR 1.60, in its current version (as revised July 1, 1996). Thus, in accordance with the present rule, the requirement is:

"Applicant indicates that the application is being filed pursuant to this section and files a true copy of the prior complete application as filed including the specification (with claims), drawings, oath or declaration showing the signature or an indication it was signed."

It is noted that applicants are fully in compliance with this present requirement of 37 CFR 1.60 inasmuch as they filed a copy of the original application, as filed, including a copy of the declaration, as it was originally filed.

Turning to the non-obviousness/non-statutory type double patenting rejection of claims 20-25, applicants again repeat their disagreement of this rejection for the grounds which were set forth in the Response dated September 5, 1996. In particular, applicants respectfully submit that the claims of the present application clearly are directed to a separate patentable invention from the patentable invention set forth in the claims of the parent U.S. Patent 5,448,520. As such, applicants respectfully submit that these separate patentable inventions are entitled to separate patents. However, in order to expedite the allowance of this application, a Terminal Disclaimer is being filed herewith to obviate this non-obviousness/non-statutory type double patenting rejection. Accordingly, entry of the attached Terminal Disclaimer and allowance of this application is respectfully requested..

If the Examiner believes that there are any other points which may be clarified or otherwise disposed of, either by telephone discussion or by personal interview, he is invited to contact applicants' undersigned attorney at the number indicated below.

To the extent necessary, the applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, Deposit Account No. 01-2135 (501.18758C14), and please credit any excess fees to said deposit account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP



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Attachments

Patents,
Trademarks, and
Copyrights

Code of
Regulations

37

Revised as of July 1, 1981

CONTAINING
A CODIFICATION OF DOCUMENTS
OF GENERAL APPLICABILITY
AND FUTURE EFFECT

AS OF JULY 1, 1981

With Ancillaries

Federal

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the Office of the Federal Register
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as a Special Edition of
the Federal Register



§ 1.60 Continuing application for invention disclosed and claimed in a prior application.

A continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121), which discloses and claims only subject matter disclosed in a prior application may be filed as a separate application before the patenting or abandonment of or termination of proceedings on the prior application. If the application papers comprise a copy of the prior application as filed, signing and execution by the applicant may be omitted provided the copy either is prepared and certified by the Patent and Trademark Office or is prepared by the applicant and verified by an affidavit or declaration by the applicant, his attorney or agent, stating that it is a true copy of the prior application as filed. Certification may be omitted if the copy is prepared by and does not leave the custody of the Patent and Trademark Office. Only amendments reducing the number of claims or adding a reference to the prior application (§ 1.78(a)) will be entered before calculating the filing fee and granting of the filing date.

[34 FR 12690, July 3, 1971]

§ 1.61 Filing of applications in the United States of America at a Designated Office.

(a) To maintain the benefit of the international filing date and obtain an examination as to the patentability of the invention in the United States, the applicant shall furnish to the U.S. Patent and Trademark Office not later than the expiration of 20 months from the priority date: (1) A copy of the international application with any amendments, unless it has been previously furnished by the International Bureau or unless it was originally filed in the U.S. Patent and Trademark Office; (2) a verified translation of the international application and a translation of any amendments into the English language, if originally filed elsewhere in another language; (3) the national fee (see § 1.445(a)(4)); and (4) an oath or declaration of the inventor (see § 1.70).

(b) Where an International Searching Authority has made a declaration that no international search report will be established because the international application relates to subject matter which it is not required to search, or because the application fails to comply with the prescribed requirements to such an extent that a meaningful search could not be carried out, the time for performing the acts referred to in paragraph (a) of this section is 2 months from the mailing date of the declaration to the applicant.

(Pub. L. 94-131, 89 Stat. 685)

[43 FR 20463, May 11, 1978]

OATH OR DECLARATION

§ 1.65 Oath or declaration.

(a)(1) The applicant, if the inventor, must state that he verily believes himself to be the original and first inventor or discoverer of the process, machine, manufacture, composition of matter, or improvement thereof, for which he solicits a patent; that he does not know and does not believe that the same was ever known or used in the United States before his invention or discovery thereof, and shall state of what country he is a citizen and where he resides and whether he is a sole or joint inventor of the invention claimed in his application. In every original application the applicant must distinctly state that to the best of his knowledge and belief the invention has not been in public use or on sale in the United States more than one year prior to his application or patented or described in any printed publication in any country before his invention or more than one year prior to his application, or patented or made the subject of an inventor's certificate in any foreign country prior to the date of his application on an application filed by himself or his legal representatives or assigns more than twelve months prior to his application in this country. He must acknowledge a duty to disclose information he is aware of which is material to the examination of the application. He shall state whether or not any application for patent or inventor's certificate on the same invention has been filed in any

foreign country, either by himself, or his legal representatives or assigns. If any such application has been filed, the applicant shall name the country in which the earliest such application was filed, and shall give the day, month, and year of its filing; he shall also identify by country and by day, month, and year of filing, every such foreign application filed more than twelve months before the filing of the application in this country.

(2) This statement (i) must be subscribed to by the applicant, and (ii) must either (a) be sworn to (or affirmed) as provided in § 1.66, or (b) include the personal declaration of the applicant as prescribed in § 1.68. See § 1.153 for design cases and § 1.162 for plant cases.

(b) If the application is made as provided in §§ 1.42, 1.43, or 1.47, the applicant shall state his relationship to the inventor and, upon information and belief, the facts which the inventor is required by this section to state.

(c) An additional statement may be required if the application has not been filed in the Patent and Trademark Office within a reasonable time after execution of the original statement.

(Sec. 1, 78 Stat. 171; 35 U.S.C. 25, 26)

[29 FR 18503 Dec. 29, 1964, as amended at 34 FR 18857, Nov. 26, 1969; 42 FR 5594, Jan. 28, 1977]

§ 1.66 Officers authorized to administer oaths.

(a) The oath or affirmation may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, the oath being attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. Such oath or affirmation shall be valid as to execution if it complies with the laws of the State or

country where made. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence as by a certificate from a clerk of court of record or other proper office having a seal.

(b) When the oath is taken before an officer in a country foreign to the United States, all the application papers, except the drawings, must be attached together and a ribbon passed one or more times through all the sheets of the application, except the drawings, and the ends of said ribbon brought together under the seal before the latter is affixed and impressed, or each sheet must be impressed with the official seal of the officer before whom the oath is taken.

If the application is made as provided in §§ 1.42, 1.43, or 1.47, the papers as filed are not properly ribboned or each sheet impressed with the seal, the case will be accepted for examination, but before it is allowed duplicate papers, prepared in compliance with the foregoing sentence, must be filed.

(35 U.S.C. 115)

§ 1.67 Supplemental oath or declaration for matter not originally claimed.

(a) When an applicant presents a claim for matter originally shown or described but not substantially embraced in the statement of invention or claim originally presented, he shall file a supplemental oath or declaration to the effect that the subject matter of the proposed amendment was part of his invention: That he does not know and does not believe that the same was ever known or used in the United States before his invention or discovery thereof, or patented or described in any printed publication in any country before his invention or discovery thereof, or more than one year before his application, or in public use or on sale in the United States for more than one year before the date of his application, that said invention has not been patented or made the subject of an inventor's certificate in any foreign country prior to the date of his application in the country on an application filed by himself or his legal representatives.